

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor:	Richard S. KUSLEIKA	Group Art Unit:	3763
Application No.:	10/825,309	Confirmation No.:	7747
Filing Date:	April 16, 2004	Examiner:	Quynh-Nhu Hoang Vu
For:	CATHETER FOR TISSUE DILATATION AND DRUG DELIVERY		

Mail Stop Petitions
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.181(a)

S I R :

The Applicant respectfully submits this petition under 37 C.F.R. § 1.181(a) requesting that, on account of new evidence cited by the Examiner in the Examiner's Answer dated January 22, 2010, the ground of rejection set forth in the Examiner's Answer be designated as a new ground of rejection. MPEP § 1207.03.

In the Examiner's Answer, the Examiner cites two references that were not previously of record in this application, specifically Rey (U.S. Patent No. 5,413,822) and Woodyard (U.S. Patent No. 3,651,591). (Examiner's Answer, pp. 7-8.)

MPEP § 1207.03 states:

A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). **>Where< a newly cited reference is added merely as evidence of the prior ** statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *> 41.39(a)(2)<. See also MPEP § 2144.03.

The Applicant respectfully submits that the Examiner's citation of new prior art should be considered as introducing a new ground of rejection. The Examiner's Answer contends that the new prior art was cited just to show that it was "well-known" in the art "that polyethylene tetrathalate or polyvinyl chloride is soft or elastic." (Examiner's Answer, p. 5.) However, according to MPEP § 1207.03, a newly cited reference can only be added "as evidence of a prior statement made by the examiner as to what is 'well-known' in the art" (emphasis added); otherwise, it would be considered to introduce a new ground of rejection. In this application, the Examiner never previously asserted that it was "well-known" in the art "that polyethylene tetrathalate or polyvinyl chloride is soft or elastic," as now asserted in the Examiner's Answer. (Examiner's Answer, p. 5.) Accordingly, the new assertion in the Examiner's Answer, along with the newly cited art in support of that assertion, should be found to constitute a new ground of rejection.

MPEP § 1207.03 further states:

If appellant believes that an examiner's answer contains a new ground of rejection not identified as such, appellant may file a petition under 37 CFR 1.181(a) within two months from the mailing of the examiner's answer requesting that a ground of rejection set forth in the answer be designated as a new ground of rejection. Any such petition must set forth a detailed explanation as to why the ground of rejection set forth in the answer constitutes a new ground of rejection.

This petition is believed to meet these requirements. Accordingly, it is respectfully requested that the ground of rejection set forth in the Examiner's Answer be designated as a new ground of rejection.

In addition to the above statements as to why the ground of rejection set forth in the Examiner's Answer constitutes a new ground of rejection, the Applicant also requests an opportunity to cite evidence in response to the new prior art cited by the Examiner in the Examiner's Answer. As discussed in the Reply Brief filed concurrently herewith, the Examiner's assertion that it is "very well-known in the art that polyethylene tetrathalate or polyvinyl chloride is soft or elastic" (Examiner's Answer, p. 5) is factually incorrect. In the Reply Brief, the Applicant cites the following references as rebutting the Examiner's assertion: (1) U.S. Patent No. 5,800,540 to Chin, (2) U.S. Patent No. 5,474,563 to Myler et al., (3) *Material Properties*, www.plasticsintl.com (attached as Exhibit A to the Reply Brief), and (4) *Polyvinyl Chloride (PVC): It's Hard to Imagine Life Without It*, www.americanchemsitr.com (attached as Exhibit B to the Reply Brief). It is respectfully requested that the ground of rejection set forth in the Examiner's Answer be designated as a new ground of rejection in order that the Applicant can present this rebuttal evidence.

CONCLUSION

For the foregoing reasons, the Applicant respectfully requests grant of this petition. The Office is hereby authorized to charge any additional fees under 37 C.F.R. §1.16 or §1.17 or credit any overpayment to Deposit Account No. 11-0600.

Respectfully submitted,

Date: 22 March 2010

/Douglas E. Ringel/
Douglas E. Ringel
Registration No. 34,416

KENYON & KENYON LLP
1500 K Street, N.W.
Washington, D.C. 20005-1257
Tel.: (202) 220-4200
Fax: (202) 220-4201

Customer Number 23838